

REMARKS

Reconsideration of the application, as amended, is respectfully requested.

Claim 12 has been amended to correct the informality. New claim 19 has been added as supported at page 23, third full paragraph.

The Office has rejected claims 1 and 7-9 under 35 U.S.C. 102(b) as being anticipated by Portman (US 6,207,638).

The claims have been amended to recite use of whey protein hydrolysate (i.e., to remove the recitation of the embodiment which uses non-hydrolysed whey protein). Since the Office points to no disclosure by Portman of whey protein hydrolysate, it is respectfully requested that the rejection be withdrawn.

The Office has also rejected claims 1, 3-5, 8, 9 and 12 under 35 U.S.C. 102(e) as being anticipated by Davis et al. (US 6,630,320).

The Office argues: "In view of the similarity in chemical composition, method of making the chemical composition, and method of administering the chemical composition, between Davis et al. and Applicant's claims, inherently administration of the compositions of Davis et al. will result in induced cellular release of glucagon-like peptides and cholecystokinins and will result in prevention of obesity or being overweight to the same extent claimed by Applicants."

Davis et al. focus on the use of whey protein hydrolysate in the treatment of hypertension. It is submitted that the Office has not established that the elements of the present claims are inevitably met by Davis et al. and that the rejection should be

withdrawn. Moreover, new claim 19 relates to a method of treating obesity or overweight.

The Office has further rejected claims 1, 3-5, 7-9 and 12 under 35 U.S.C. 103(a) as being obvious over Davis et al. and further in view of Katz et al. (US 2002/0081315) and Ward et al. (US 2003/0165574). According to the Office it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to treat hypertensive patients who are also obese according to the method of Davis et al., because Katz et al. teach that obesity and hypertension are commonly associated with each other, and because Ward et al. teach that the treatment of Davis et al., due to ACE inhibition would have been expected to have the additional benefit of enhancing weight loss in the patients being treated.

The Office cannot validly argue that it is obvious to treat obese or overweight patients using a protocol that is known for the treatment of hypertension, simply because some hypertensive patients are also obese.

Even though it can remain undisputed that obesity and hypertension are commonly associated, this fact does not imply that it would have been obvious to apply the method of treating hypertension according to Davis et al. to induce weight loss in obese or overweight individuals. It is well-known that hypertension also frequently occurs in individuals who are not obese. Therefore, it cannot be argued that the treatment of obesity and the treatment of hypertension *de facto* target the same population of patients. Consequently, it would not be obvious to a person skilled in the art to employ a known method for treating hypertension to induce weight loss in obese or overweight individuals.

Although it could possibly be argued that it would be obvious to treat obesity to thereby reduce the risk of hypertension, the converse is not true. Thus, it is submitted that it

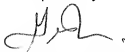
would not be obvious to apply the teaching of Davis et al. alone to induce weight loss in obese or overweight individuals.

As to Ward et al., the Office has not demonstrated that it is available as a reference in the present application. Moreover, although the Office has argued that Ward et al. teach that the treatment of Davis et al., due to ACE inhibition would have been expected to have the additional benefit of enhancing weight loss in the patients being treated, the PTO's reasoning is based on the assumption that Davis et al. teach whey protein hydrolysates with ACE inhibiting activity. However, although the Office points to Davis et al's reference to ACE inhibition at col. 4, lines 46-50, the Office points to no such explicit teaching by Davis et al. Thus, it would appear that only with the benefit of hindsight one can argue that a skilled person would be incited to combine the teachings of Ward et al. with those of Davis et al.

Although the propriety of the obviousness double patenting rejection is not conceded, applicants are amenable to filing a Terminal Disclaimer upon indication of allowable subject matter in order to expedite prosecution of the application.

In view of the foregoing, it is respectfully requested that the application, as amended, be allowed.

Respectfully submitted,



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